

REMARKS

The above amendments with the following remarks are submitted to be fully responsive to the Office action dated January 12, 2009. Claims 1-11 are pending in the present application. The present amendments amend claims 1, 3 and 7, and amend the specification and abstract in light of the currently amended claims for better readability without the introduction of new matter (see, e.g., FIG. 3, and original claims 1 and 3). Therefore, claims 1-4 and 7-9 are now pending in the present application and are believed to be in proper condition for allowance. Reconsideration in view of the above amendments and the following remarks is respectfully requested.

First, Applicants wish to thank the Examiner for allowing claims 5, 6, 10 and 11 as previously presented. In addition, Applicants submit that claims 1-4 and 7-9 are also in condition for allowance, as set forth in detail below.

Claims 1-4 and 7-9, as presented, patentably distinguish over the applied references, (1) German Publication 29616832; (2) Kunz et al. (US 3,914,175); (3) Fruman (US 4,022,694); (4) UK patent 1,418,806; (5) PCT publication WO 02/20115; (6) Castelli (US 3,957,656); (7) Batutis (US 4,278,545); (8) Kingsbury (US 3,231,091) and (9) Lawson (US 2,405,838), as the applied references, alone or in combination, fail to disclose, teach or suggest all of the features recited in the pending claims.

In particular, the Examiner states that:

“It is well known to use a polymer absorbent material, such as a foam, as a coalescer, as exemplified by [Fruman], the British patent and the PCT publication. It would therefore have been obvious for one skilled in the art to use such a polymer absorbent as a coalescer in the devices of Kunz and the German publication, as a substitution of one known suitable material for another.”

Applicants respectfully disagree.

In re Claims 1-4, 7 and 9 Rejected under 35 U.S.C. 103(a)

1. No Suggestion to Combine Fruman, the UK patent, the PCT publication, Kunz, the German publication, Castelli and Batutis.

There is no suggestion in any one of the above references that such disclosure should be combined with any one of the other above references. Moreover, one skilled in the art at the time of Applicants' invention wishing to provide a separating system and method with guiding means made of an oleophilic material would not consider combining the teachings of the above references. As recited in currently amended claim 1, the system comprises: (emphasis added)

one or more separating and guiding means *made of an oleophilic material, each separating and guiding means being located a distance from an associated coalescing element and being disposed at an output of the associated coalescing element to guide said detached large drops for further recovery* and having a structure that is adapted to allow the continuous phase to flow through the separating and guiding means.

Neither Fruman, the UK patent, the PCT publication, Kunz, the German publication, Castelli nor Batutis, singularly or in combination, provide some teaching, suggestion, or motivation that would have led one of ordinary skill to modify any of the references or combine the references to separate a water/hydrocarbons emulsion fluid into a recovered oil fluid and a purified water fluid utilizing separating and guiding means made of oleophilic material wherein each separating and guiding means are located a distance from an associated coalescing element. The only apparent reason the Patent Office could have for trying to combine these disparate references is to try to invalidate claims 1-4, 7 and 9. It should be noted that the impropriety of using an applicant's claim as a roadmap and motivation for combining references is well-known. Applicants respectfully remind Examiner of his duty under MPEP 2142:

To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical “person of ordinary skill in the art” when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention “as a whole” would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the “differences,” conduct the search and evaluate the “subject matter as a whole” of the invention.

2. Combination of Fruman, the UK patent, the PCT publication, Kunz, the German publication, Castelli and Batutis would change the principle operation of each.

Combining Fruman, the UK patent, the PCT publication, Kunz, the German publication, Castelli and Batutis does not seem to result in anything operable, or even discernible. As directed in MPEP 2143.02, a proposed modification cannot change the principle operation of a reference or render a prior art unsatisfactory for its intended purpose. Applicants fail to discern how any of the above references could reasonably be modified by any of the other references. The Office action asserts that it would have been obvious for one skilled in the art to use a polymer absorbent (i.e. the foam taught by Fruman, the UK patent and the PCT publication) as a coalescer in the devices of Kunz and the German publication, as a substitution of one known suitable material for another. Applicants do not see how a “Kozlowski polyurethane” (as taught by the PCT publication) which is ‘squeezable’ (as taught by Fruman) and “saturated with liquid petroleum” (as required by the UK patent) could be used in a “zig-zag” arrangement (as taught by Kunz) with “daß die Leitelemente” (as taught by the German publication) having “corrugated separator plates with bleed holes” (as taught by Castelli) for “removing solid materials from a fluid mixture” (as taught by Batutis). Clarification is respectfully requested.

3. Combination of Fruman, the UK patent, the PCT publication, Kunz, the German publication, Castelli and Batutis does not result in claimed invention.

Even if the above teachings could be combined in some reasonable manner, such combination would not result in the invention claimed in claims 1-4, 7 and 9. For example, newly amended claim 1 requires “each separating and guiding means being located a distance from an associated coalescing element.” None of the above references, either singularly or in combination, disclose a separating and guiding means made of an oleophilic material located a distance from an associated coalescing element. Applicants respectfully point to the guidance provided by MPEP 2143.03, where it is stated, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” Applicants fail to see how the applied references disclose separating and guiding means as presently claimed. Clarification is respectfully requested.

In re Claim 8 Rejected under 35 U.S.C. 103(a)

Examiner rejected claim 8 under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 7 above, and further in view of Kingsbury or Lawson. Applicants rely on the above discussion that the combination of Fruman, the UK patent, the PCT publication, Kunz, the German publication, Castelli and Batutis does not render independent claim 7 unpatentable, and that the added disclosures from Kingsbury and/or Lawson do not render the claim depending therefrom obvious. As such, Applicants’ novel, unobvious, and useful separating system and method with guiding means made of an oleophilic material are considered to be patentably distinguishable in view of the prior art.

CONCLUSION

Applicants have intended for this to be a full response to the Office action. Applicants believe that the application is now in condition for allowance and earnestly seeks such by the Examiner. However, if the Examiner deems that any issue remains after considering this response, the Examiner is invited to contact the undersigned attorney to expedite the prosecution and engage in a joint effort to work out a mutually satisfactory solution.

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